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In re Application of  
YAMASAKI et al.  
Application No.: 09/647,772  
PCT No.: PCT/JP99/01798  
Int. Filing Date: 04 April 1999  
Priority Date: 05 April 1998  
Attorney Docket No.: 06501-065001  
For: INDOLE DERIVATIVES

DECISION ON  
PAPERS UNDER 37 CFR 1.42

This a response to the declaration filed 04 April 2001 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

**BACKGROUND**

On 04 April 1999, applicants filed international application PCT/JP99/01798, which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 October 1999. On 20 October 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 05 October 2000.

On 04 October 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and the international application.

On 06 November 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 04 April 2001, applicant filed the surcharge under 37 CFR 1.492(e) and a declaration and power of attorney executed by Noritsugu Yamasaki; Takafumi Imoto; Hiroshi Kayakiri; Osamu Onomura; Takahiro Hiramura as inventors and Noriko Oku, Chikado Oku, and Tomohito Oku on behalf of deceased inventor, Teruo Oku.

**DISCUSSION**

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.)

of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 04 April 2001 was executed by Noriko Oku, Chikado Oku, and Tomohito Oku as "representatives" of deceased inventor, Teruo Oku. However, the declaration does not state that Noriko Oku, Chikado Oku, and Tomohito Oku are the "legal" representatives or are all of the heirs of the deceased inventor. Accordingly, the declaration fails to identify the proper relationship under 37 CFR 1.497(b)(2).

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the signing heir. The declaration filed on 04 April 2001 appears to provide this information with respect to the signing heir, but not the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3).

Moreover, a review of the declarations filed on 04 April 2001 reveals that the declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration submitted includes two sheets numbered 2. It is unclear if the inventors were presented with only page 2, in which case the execution would be improper, or they if were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 04 April 2001, which is improper. (See MPEP 201.03)

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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